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EDWARD ELIAS DROPLEY
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IN THE

Supreme Court of the United States

OCTOBER TERM 1944

No. 1251

THE WESTERN STATES MACHINE COMPANY

Petitioner,

v.

S. S. HEPWORTH COMPANY,

Respondent.

**PETITION FOR WRIT OF CERTIORARI AND
SUPPORTING BRIEF**

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DESIGNATIONS

The record consists of Volumes A, B, C, D and E. Pages in the respective volumes are referred to as RA, ——, RB, ——, etc.

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THE WESTERN STATES MACHINE COMPANY

Petitioner,

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S. S. HEPWORTH COMPANY,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT**

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE
JUSTICES OF THE SUPREME COURT OF THE UNITED
STATES:

Your petitioner, The Western States Machine Company, respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to review those portions of its judgment entered February 9, 1945 (RE. 203) as to which a petition for rehearing was denied (RE. 202) and by which claims of three United States patents were held either invalid or not infringed and a judgment enforcing the patents in the United States District Court for the Eastern District of New York (RA. 76-79) was thereupon reversed.

A certified transcript of the record including the proceedings in the Circuit Court of Appeals has been filed herein pursuant to Rule 38.

Jurisdiction

Jurisdiction is conferred by Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c.229 (U. S. Code, Title 28, Sec. 347).

Summary and Short Statement

The patents and claims in issue are:

- I. No. 1,758,901, filed Dec. 8, 1925, issued May 13, 1930, called the "Control" patent,—as to claims 1, 3, 4, 5, 9 and 10, held not infringed;
- II. No. 2,145,633, filed June 23, 1934, issued Jan. 31, 1939, called the "Separator" patent,—as to claims 10 and 12, held invalid; and
- III. No. 2,096,341, filed Nov. 30, 1934, issued Oct. 19, 1937, called the "Brake Cooling" patent,—as to claim 8, held invalid, and claim 9 held not infringed.

Each patent was granted for an invention of Eugene Roberts and is owned by petitioner (RA. 77).

The subject matter is sugar centrifugals. In making sugar, syrup is boiled until a hot, viscous mass of sugar crystals in molasses has formed. Heavy centrifugal machines, having perforated baskets to be whirled at high speeds, are used to separate the molasses and purify the crystals. Each centrifugal must be operated for many successive "cycles", treating a charge of 9 cubic feet or so in each cycle, to process an entire boiled mass. Then another mass is processed.

Eugene Roberts started working on such machines over 50 years ago, at age 15, as a mechanic in a beet sugar factory (RA. 181). He soon displayed inventive abilities and was granted patents, and he founded petitioner in 1918 to carry forward his work. Of the patents here involved the district court said:

"The plaintiff's patents were * * * successfully embodied in commercial structures which found a ready market from about 1926 until the filing of these suits. In other words, plaintiff's commercial success is not questioned. Commencing in 1936 the defendant inaugurated its own efforts to compete with the plaintiff * * *" (RA. 4).

I. The Control patent (Ex. 1, RB. 686, RA. 83) disclosed a sugar centrifugal controlled partly by hand and partly by automatic means, having a semi-automatic combination of driving, braking, spraying, timing and starting elements by which the centrifuging of any mass of crystals and syrup can be predetermined adjustably to suit the needs of the mass and then kept uniform for all of the many charges treated in the successive operating cycles required to process it all. Each mass differs from every other, and each mass is subject to changes of viscosity while awaiting treatment. Yet by the combinations of this patent each of the three phases of actual centrifugal treatment upon each charge can be adjusted and set to suit any quality of mass being processed; and the treatment so scheduled can be held the same for every charge in the successive cycles because the loading or starting and the discharging phases of the cycles are kept under normal manual control, to allow for the changes of quality and viscosity that occur, and when the sugar has been centrifuged in each cycle as scheduled the machine is quickly and automatically brought to a stop.

The Roberts invention dates from 1923 (RA. 71). It reduced waste, improved products, saved manpower and machines and made possible the scientific handling of

sugar refining work; and so it "proved to be an important contribution to the industry in which it was employed" (RA. 10).

The district court held that "the presumption of validity which has frequently been recognized as attaching to the grant of Letters Patent is well fortified as to these Roberts patents" (RA. 30), and patentable invention was found in that "a new and operable combination of several elements constituting together one machine is disclosed, which has been shown to perform an important, novel and useful function" (Finding 4a, RA. 71).

Respondent's machines (Ex's. 64-66, RB. 764-769, RA. 323, 325) were designed to use electrically and pneumatically motivated parts in place of mechanically and spring-motivated parts shown for corresponding service in the drawings of the Control patent. These were recognized as equivalents (RB. 739, RA. 207-208, 357, 400-401, 409-410) and were held to be so in the district court. The evidence was undisputed that the infringements charged use the features disclosed in the patent, to serve the same purpose and perform in the same way (RA. 402-410, 415-416, 417-418, 421, 492, 495), and they embody the claimed combinations completely, as to every element, operation and result. They are identical. This the district court meticulously explained (RA. 41-45), and the Circuit Court of Appeals conceded it as to the claims as they stand (RE. 169, 173).

In 1928, long after the Roberts invention, patent No. 1,669,927 was issued to *Carlson*, for an "Apparatus for Washing Sugar and the Like" (Ex. V, RB. 783, RA. 534). The patent was never used, and respondent's expert testified that it "does not identify a complete disclosure" (RA. 531). It proposed merely a combination of two incomplete timer elements arranged to operate a sprayer device and to be actuated by the drive connecting device of a centrifugal upon the start of basket rotation. The *Carl-*

son application, filed July 22, 1922, was pending in secrecy at the dates of the Roberts invention and application.

Respondent contended in the district court that its control mechanisms were more like *Carlson's* sprayer apparatus than like the control mechanism of Roberts, but the district court held otherwise:

"If only turning wash water on and off were involved in the Roberts patents, the contention would be formidable. Since that is not the Roberts invention, it seems that each control mechanism must be studied as a composite whole, and any useful comparison upon that basis points to their basic similarity in organization and performance" (Opinion RA. 38).

The Circuit Court of Appeals, accepting the district court's statement of facts (RE. 168), called the Roberts invention one "to take the old centrifuges and make them automatic throughout" and said of *Carlson* that "the art had already made a centrifuge, automatic in all but the last phase: i.e. stopping the basket at the end of the drying period". It held that *Carlson* must be given effect as though published and known to skilled workers before Roberts' invention, when *Carlson* in fact was unknown; that since Roberts made his advance "only a year after *Carlson* filed his application, there would be no warrant for allowing it to be the basis of a patent"; that the claims might be circumscribed because of *Carlson* by reading in limitations from the specifications, if they were for a meritorious invention*: and that "whatever latitude remains to them, when so circumscribed, they will not cover the defendant's apparatus". In this way the judgment as to the Control patent was reversed, for non-infringement.

* The claims were granted after citation of *Carlson* (RE. 135), and they are clearly distinguished from *Carlson* as to the elements combined and the combinations, operations, and results as a whole.

II. The Separator patent (Ex. 4, RB. 693, RA. 83) disclosed the first successful apparatus for recovering separately the molasses and the purer wash syrup that result consecutively from purging and then washing the whirling charge treated in each cycle of sugar centrifugal operation. Roberts conceived it in 1933 (RA. 227-230). Of the prior art, the district court stated:

*** * * The evidence is undisputed that separation was required, and it was not accomplished successfully" (RA. 47).

The finding was of "patentable invention, which performed a useful and important function" (RA. 73), and infringement of claims 10 and 12 was found (RA. 74).

Respondent's main defense was that the claims were anticipated by a part of *Holland* patent No. 703,728, granted July 1, 1902 (Ex. TT, RB. 803). This was rejected in the district court, because of *Holland's* lack of a corresponding teaching, the incompleteness and indefiniteness of his disclosure and its failure of use in more than 30 years of unfulled need that followed before Roberts' success (RA. 50-51). Yet the Circuit Court of Appeals gave to an unpatented part of *Holland's* specifications (the description related to Fig. 4) a presumption both of operability and of sufficiency to advise the art of what Roberts claimed, saying that "the examiner passed the disclosure", and it held thereupon that the claims were anticipated and that it was immaterial whether the prior patent were "as little a contribution to the sum of knowledge as though it had never existed" (RE. 174-175).

Holland's disclosure is ambiguous and incomplete on its face. There was evidence that the part of it relied upon was both impractical to make and inoperative (RA. 673, 675), but there was no evidence of its operability or sufficiency. Respondent simply offered the patent and had an employee relate his interpretation of Fig. 4 (RC. 545-547)—

an unreliable interpretation (RA. 669-672). The matter patented to *Holland* (RB. 803, Ex. TT, p. 1, lines 14-21, and p. 2, claims 1 to 4) is inconsistent with the description relied upon and clearly unlike the Roberts invention.

The invention *Holland* claimed would have an annular plate guide syrup to either of two places by having its outer edge always in contact with the curb so that syrup would always flow over the plate and its inner edge, to one side of a partition in one plate position and over the top of the partition to its other side in the other plate position. Several essentials of Roberts are thus lacking: (1) The seat or ledge on the curb with respect to which the outer edge of a ring deflector is either sealed or spaced away in the respective ring positions, (2) the ring deflecting syrup only in one position—to an inner trough when seated, (3) the ring overlying the partition of the inner trough, (4) the ring inactive—not guiding syrup—in its unseated position, (5) the single circular line of separation resulting from the above, and (6) disclosure of a way to work the ring.

The description of *Holland's* Fig. 4 speaks of having a space between the curb and the outer edge of the plate in the raised position of the plate, but even the description does not contain any of essentials (1), (3), (5) and (6) aforementioned.

III. The Brake Cooling patent (Ex. 5, RB. 695, RA. 83) disclosed a water-cooled brake system for sugar centrifugals, invented in 1934. It also achieved commercial success (RA. 56), and was found to "contribute an important element to high speed of rotation of the centrifugals and thus to the enhanced possibility of their performance in a given unit of time" (RA. 74).

The system embodies a brake drum on a vertical centrifugal shaft, constructed as an open top annular trough to hold a body of water while either rotating or at rest;

together with an offtake (shown as a scoop pipe) to remove heated water during each running period of the machine as the water body exceeds a certain volume determined by the capacity of the drum and the setting of the offtake; and together with an intake having a control device for supplying cool water to the body within the drum simultaneously with the action of the offtake. The intake control is coordinated with the centrifugal operation so that cool water is supplied only during the running periods while the offtake functions, the supply being terminated whenever the machine is brought to rest.

In this way water is kept from overflowing the drum or accumulating in it in such excess as to splash around the machine during the next running period. But the outstanding function of the system was the new capacity it imparted to the brake (RA. 241, 475, 503-506), which it accomplished in a new way by the constant maintenance of a body of water in the brake drum and the gradual replacement of heated water in this body by cool water between the successive brake operations (RA. 457, 461-463). Without this system and its effective graduation of temperature changes brake drums had quickly cracked and broken under the intensive strains imposed by short cycle centrifugal operations, wherein the brake must absorb the full kinetic energy of the heavy whirling machine, as heat, every two to three minutes (RA. 235-237, 503-504).

The only old element of the Roberts brake cooling system was the scoop offtake, which had been used since before 1928 in the *Baltimore Use*. There the centrifugal brake drum had bottom outlets, to discharge its water into a catch pan fixed below while the machine was at rest, together with a continuous intake at a limited rate (RA 641-642). Not only splashing (RA. 663-664) but low cooling capacity (RA. 644, 679) and early abandonment of attempts to market it (RA. 297) characterized the *Baltimore* system.

Respondent's machinery embodied the Roberts system

completely. It differs from the illustrations of the patent only in the substitution of a different intake control device coordinated to function in the system in the same way as Roberts' control valve, as explained in the opinion of the district court (RA. 59-63).

The district court, finding two distinctive features of patentable invention in the Brake Cooling patent, held claim 9 valid and infringed (RA. 59, 63) but considered claim 8 broadly readable upon the *Baltimore Use*, hence invalid (RA. 58, 59).

The Circuit Court of Appeals, in contrast, found claim 8 not anticipated, but dismissed it nevertheless by saying:

"There could be no invention in such a change as that; * * * one cannot have a patent merely for 'plugging up a hole.' Claim eight was either a useless variant, or it presupposed the stoppage of the supply; since the stoppage cannot be inferred because it occurs in claims nine and ten, claim eight is invalid" (RE. 176).

Then the Circuit Court of Appeals dismissed claim 9 for non-infringement, saying:

"* * * the claim must be read generally to cover all means which cut off the water; and to generalize the claim so far, would leave nothing for invention but the bare conception of turning off the water when the rim stops. * * * Claim nine may still be valid; we do not say; but, if it is, it covers only means which stop the water supply by a measurably similar mechanical train as that shown in the specifications: the defendant's apparatuses do not infringe it" (RE. 177).

Thus, there were three patents, each granted for a practical advance of a traditional inventor which performed in a new way, accomplished important new results and achieved commercial success. The district court stated that " * * * the accomplishments fairly to be attributed to the plaintiff's patents have been in the public interest * * *" (RA. 5). The Circuit Court of Appeals, for one

reason or another, has denied enforcement to all three patents by so changing or invalidating their claims as to destroy their effects. Yet nothing that existed before was the same or capable of equivalent performance, while the defendant's structures are the same for they are substitutes which clearly embody the inventions patented, even though their differences from details illustrated in the patents may make them appear different to the unskilled. The trial court reached quite the opposite result upon its full consideration and understanding of the evidence and the applicable law.

Questions Presented

1. Where the claims of a patent distinguish improvements and combinations of great utility from the prior art, is it now permissible for a court to change them by circumscribing them to illustrative details of the specifications, so as to hold them not infringed by machinery embodying the same improvements and combinations without the illustrative details?
2. Does the law now sanction the avoidance of infringement of claims to mechanical combinations and attendant destruction of their value through the device of so embodying the claimed combinations that the forms or details of parts used differ from the forms or details of parts used correspondingly in the illustrations of the patent?
3. Was it proper for the Circuit Court of Appeals to measure the extent of "invention" attributable to the Control and Brake Cooling patents and to change their claims to ineffectiveness by making simple characterizations of the verbal distinctions in the claims over the prior art and asserting that such characterizations could not "be the basis of a patent" or "could be no invention", where the record shows indisputably that each patent disclosed

and by its claims distinguishes a new, beneficial and successful combination or device which was never known or taught in the prior art?

4. Is a copending patent application which was filed earlier than but published long after the invention and application dates of a patent in suit to be considered as having on its filing date the same effect as a printed publication known to workers in the art, and as the base from which to start measuring the patentee's ingenuity, or how easy his invention might have been to skilled workers, or how long a period was required to bring it about, where the copending application does not disclose the claimed invention and so does not negative its novelty or show prior invention of it by others under the rule of this court in *Alexander Milburn Co. v. Davis-Bourneville Co.*, 270 U. S. 390?

5. Is there a legal presumption that matter described in part of an expired patent, as relied upon for the defense of anticipation of a later successful invention, was operable or sufficient to teach the art how to accomplish the result sought, where the prior patent was not granted for that matter but covers something different and non-anticipatory in its general description and claims of invention?

6. May a particular part of the specifications of an expired patent be presumed operable and sufficient to anticipate a patent in suit, where there is no evidence affirming its operability or its sufficiency but there is evidence of its inoperativeness and insufficiency and the result sought was accomplished only by the invention of the patent in suit, more than 30 years after the prior patent?

7. Is it immaterial that a prior patent asserted as an anticipation of a later successful invention was as little a contribution to the sum of knowledge as though it had never existed?

8. May the disclosure of a prior patent be presumed operable and sufficient to advise the art, and thereupon be held an anticipation of claims to a later successful invention, where the disclosure on its face is ambiguous, indefinite and incomplete as to the matter in question and contributed nothing to the practical art?

9. Is claim 8 of the Brake Cooling patent invalid merely because the essential novelty it sets forth seemed simple to the Circuit Court of Appeals or useless except in connection with other novelty disclosed in the patent, where the matter claimed has been used successfully to accomplish new results in both the patentee's and the infringer's commercial structures, and it was neither known nor taught by the prior art?

Reasons for Allowance of the Writ

1. The decisions of the trial court and the Circuit Court of Appeals are in direct conflict as to the principles of law and conclusions applicable to the same facts, and there is no likelihood of an adjudication in another circuit leading to a decision by this court because:

(a) The judgment precludes a further suit on the same issues against the respondent or customers of the respondent in another circuit;

(b) The business affected is small, consisting mainly in the replacement of existing machinery in sugar factories and refineries (RA. 186), which are relatively few in number, by specialized machinery embodying the inventions in suit (RA. 272-273); and none of the other concerns dealing in sugar centrifugals (RA. 274) is known to have infringed;

(c) The Control patent—most basic of those in suit—expires within two years, so that a further expensive suit

to protect it against infringements of future occurrence would hardly be practical, should cause arise; and

(d) Petitioner is a very small company having limited resources (RA, 180) which have been severely burdened by respondent's activities since 1936 and by the expenses of this suit. Petitioner is unable reasonably to afford a further similar suit should cause arise in the near future, and unless this court allows the writ there will be no protection of valuable rights duly granted by the Patent Office and believed unjustly denied protection by the Circuit Court of Appeals.

Wrts of certiorari have been allowed by this court in like cases upon conflict between the trial and the appellate courts of one circuit, in *Hildreth v. Mastoras*, 257 U. S. 27; *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537; *Minerals Separation v. Hyde*, 242 U. S. 261; *Exhibit Supply v. Ace Patents*, 315 U. S. 426; and *Sinclair & Carroll Co. v. Interchemical Corp.*, 89 L. ed. 236 (memo.).

II. In respect of the Control patent and the effect thereupon of Carlson's copending application the Circuit Court of Appeals has decided an important question of federal law which has not been but should be settled by this court. It is important to the public and to the proper administration of the patent laws that this court decide whether the rule of the *Milburn* case properly may be extended to permit the use made of *Carlson* in this case; especially since the decisions of other federal courts¹ and

¹ *In re Spencer*, 47 F. (2d) 806, 807 (C. C. P. A., 1931); *Baltimore Paper v. Oles Envelope*, 13 F. Supp. 951, 954 (D. Md. 1936), aff'd. 89 F. (2d) 279 (C. C. A. 4th); *Hazeltine v. Coe*, 87 F. (2d) 558 (Appeals D. C.) and *Dyer v. Coe*, 125 F. (2d) 192, 196 (Appeals D. C.); *Johns-Pratt v. E. H. Freeman*, 201 Fed. 356 (D. N. J.), aff'd. 204 Fed. 288 (C. C. A. 3rd, 1913); *Utah Radio v. Delco*, 24 F. Supp. 328 (W. D. N. Y., 1938).

prior decisions of the Circuit Court of Appeals for the Second Circuit² conflict with the decision in this case; and since the practice in the Patent Office does not conform with the necessities of such decision.

III. In refusing to enforce claims of the Control and the Brake Cooling patents by limiting them beyond any fair construction of their terms, the Circuit Court of Appeals has unduly extended a restrictive policy toward patents declared by it in *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 636, and has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this court's power of supervision.

IV. In holding claims of the Separator patent anticipated by an unpatented and incomplete part of the specifications of the *Holland* patent, which the court presumed operable and sufficient to anticipate notwithstanding that the only evidence on the subject was to the contrary and regardless of whether *Holland* made any contribution to the sum of knowledge, the Circuit Court of Appeals has decided a federal question which has not been but should be settled by this court, and in a way probably conflicting with applicable decisions of this court in *Whitely v. Swayne*, 7 Wall. (74 U. S.) 685, 686, *Coffin v. Ogden*, 18 Wall. (85 U. S.) 120, 124, *O'Reilly v. Morse*, 15 How. (56 U. S.) 62, 110, *Seymour v. Osborne*, 11 Wall. (78 U. S.) 516, 552, and *DuBois v. Kirk*, 158 U. S. 58, 65, as considered with the applicable decision in *Sewall v. Jones*, 91 U. S. 171, 185, 186, and other cases.

V. In its holding on claim 8 of the Brake Cooling patent the Circuit Court of Appeals has decided a federal

² *Stelos v. Hosiery*, 72 F. (2d) 405, 406 (C. C. A. 2nd, 1934); *Comolite v. Davidoricz*, 111 F. (2d) 121, 123 (C. C. A. 2nd, 1940).

question in a way probably in conflict with applicable decisions of this court in *Deering v. Winona Harvester Works*, 155 U. S. 286, 302; *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 440, 441; *The Barbed Wire Patent*, 143 U. S. 275, 282, and other cases.

VI. The decision of the Circuit Court of Appeals gives dangerous and unjust sanction and encouragement to the colorable evasion of patent rights through the designing of structures to use claimed inventions with parts or elements differing in detail or form from the details or forms illustrated in the patent, and through the praising of unwanted and non-anticipatory prior art to courts while using the claimed inventions instead. Thereby the court has withheld the protection assured by law for the origination and development of meritorious improvements, contrary to public policy and applicable decisions of this court.

By changing rather than fairly construing the claims in suit, and otherwise in deciding the questions aforementioned and reversing the judgment of the district court, the Circuit Court of Appeals has decided federal questions in ways conflicting with applicable decisions of this court in *Smith v. Snow*, 294 U. S. 1, 11-14; *Winans v. Denmead*, 15 How. (56 U. S.) 330, 341; *White v. Dunbar*, 119 U. S. 47, 51; *Cimiotti v. Am. Fur*, 198 U. S. 399, 409; *Minerals Separation v. Butte*, 250 U. S. 336; *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 434, 435, 441; *Seymour v. Osborne*, 11 Wall. (78 U. S.) 516, 548, 553; *Minerals Separation v. Hyde*, 242 U. S. 261, 270; *The Corn-Planter Patent*, 23 Wall. (90 U. S.) 181, 223; *The Barbed Wire Patent*, 143 U. S. 275, 282, 283; *Sanitary Refrigerator v. Winters*, 280 U. S. 30, 41, 42; *Hobbs v. Beach*, 180 U. S. 383, 401; *Cochrane v. Deener*, 94 U. S. 780, 787; *Mason v. Graham*, 23 Wall. (90 U. S.) 261, 274; *Hildreth v. Mastoras*, 257 U. S. 27; *Williams v. United Shoe Machinery*, 316 U. S. 364; and other cases.

WHEREFORE, your petitioner respectfully prays that the writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit, to the end that this cause be reviewed by this court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioner have such other and further relief as may be proper.

THE WESTERN STATES MACHINE COMPANY,

By ALBERT C. JOHNSTON,
NELSON LITTELL,
Counsel for Petitioner.

Statement of the Case

The essential facts and the conclusions of the courts below are stated in the petition.

It may be added that the Control invention overcame problems that had baffled far more numerous workers for a far longer time than might appear from the opinion below. Sprayers for centrifugals had been rendered mechanically operative long before *Carlson's* proposal, first by Roberts and afterward by *Knapp* and others. But the larger and relevant problem of mechanically controlling the sugar centrifugal itself had escaped numerous attempted solutions. Many were cited in the file wrapper of the Control patent (Ex. BB) and many in respondent's bill of particulars (RE. 1-2), dating back to before 1900. Respondent relied unsuccessfully in the district court upon the *Herr* proposals filed in 1915 (Ex. QQ-2, RB. 800) and 1923 (Ex. QQ-1, RB. 798) and the *Andrews & Newman* proposal filed in 1922 (Ex. R, RB. 776). Several other attempts of early date are described in *Deerr*, "Cane Sugar" (1921), page 427 (Ex. 7, RB. 699, RA. 95), which states that "no great success has been obtained so far".

Specification of Errors

The Circuit Court of Appeals erred:

1. In circumscribing claims of the Control and the Brake Cooling patents to illustrative details of the respective specifications not claimed as the Roberts inventions.
2. In holding the disclosure of the copending *Carlson* patent to be a limitation upon the scope of the Control patent.
3. In holding the Control and Brake Cooling patents not infringed by respondent's manufacture and sale of

structures embodying the parts, improvements and combinations disclosed and claimed as the Roberts inventions.

4. In according presumptions of operability and sufficiency of disclosure to an unpatented part of the specifications of the *Holland* patent.

5. In holding claims 10 and 12 of the Separator patent invalid as anticipated by *Holland*.

6. In holding it immaterial whether any contribution to the sum of knowledge was made by matter contained in a prior patent and offered in anticipation of claims granted for a later successful invention.

7. In holding claim 8 of the Brake Cooling patent invalid because the novelty it distinguishes seemed to the court either "useless" or so simple a change that it "could be no invention".

8. In reversing the judgment of the district court as to all claims in issue except claim 8 of the Brake Cooling patent, and as to costs, and in affirming the district court as to that claim.

ARGUMENT

A sound public policy applicable to this case holds the claims of a patent as the measure of its scope and forbids circumscribing them to details not imported by a fair construction of their terms.

The constitutional purpose to promote the progress of the useful arts is implemented by patent laws which authorize the grant of exclusive rights to whomever has invented any new and useful art or machine, or any new and useful improvement thereof, and whose application duly made has been examined by an expert in the Patent

Office and found to comply with the requisites. R. S. § 4886, U. S. Code, Title 35, See, 31.

Among the requisites is that there shall be filed a written description which, in case of a machine, shall explain the *best mode* in which the applicant has contemplated applying the principle of his invention "so as to distinguish it from other inventions". And then "he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention". R. S. § 4888, U. S. Code, Title 35, See, 33.

So the invention patented is the matter claimed, of which the mode of application explained in the description is illustrative but not restrictive. The focal point of examination is the claims. When allowed in mechanical cases they presumably have been found by a qualified expert to distinguish from other inventions some part, improvement or combination of a machine of which an illustrative embodiment has been sufficiently explained, which the applicant was the first to invent, and which at the time of his invention was new and useful and involved ingenuity beyond that then expectable of mechanics skilled in the art.

The claims thus give a workable measure of the novel matter that may or may not be used during the life of the patent without license. The description does not. It is explanatory and detailed, and patentable invention seldom lies in mere detail. It often presents but a crude exemplification, for the law encourages early filing once an invention has been publicly disclosed, while the evolution of the first working organization to ultimate forms often takes years and great expense. To encourage his original efforts and their development the law protects the inventor, not merely as to details but as to the substantial features distinguishing his advance from other inventions. They are measured by the claims. To the

extent of their advantages and success he may be rewarded; while the public gains knowledge of the new features and their advantages, and the public is apprised by the claims of what the patent exclusively controls for seventeen years, no matter in what form others might make it appear.

"But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention", *Smith v. Snow*, 294 U. S. 1, 11, 12.

"In making his claim the inventor is at liberty to choose his own form of expression, and *while the courts may construe the same in view of the specifications and the state of the art, they may not add to or detract from the claim*. *Cimiotti v. Am. Fur*, 198 U. S. 399, 409. (Italics added.)

Courts may not properly restrict a claim to a particular form of machine unless it cannot fairly be construed otherwise. *Winans v. Denmead*, 15 How. (56 U. S.) 330, 341. So strong is the principle involved that the judicial construction of claims in a manner different from the import of their terms has been aptly described by this court as "unjust to the public, as well as an evasion of the law". *White v. Dunbar*, 119 U. S. 47, 51; *Minerals Separation v. Butte*, 250 U. S. 336.

Even where claims were limited in terms to a device "substantially as described" this court held that "another construction, which would limit those words to the precise mechanism described in the patent, would be so obviously unjust that no court could be expected to adopt it." *Hobbs v. Beach*, 180 U. S. 383, 399.

Yet the Circuit Court of Appeals in this case has thus limited claims which contain no restrictive words. Where Roberts had invented new control combinations and was granted claims for them, the court has "circumscribed" his patent to mechanical details of a timer element. Where Roberts invented a new brake cooling system for

maintaining a body of water in the brake drum and cyclically replacing the heated water by cool water, and was granted claims for the brake drum construction and the intake control distinguishing this system, the court has "circumscribed" his patent to details of a valve operating mechanism.

The result of courts changing patented claim is to nullify the lawful expectations upon which developments are ventured, business is created and contracts are laid, as well as to destroy the measure by which men may determine what is or is not open to free business use. This can be illustrated by the facts of this case:

Roberts held the assets of insight, ingenuity and a zeal to make sugar centrifugals perform as they never had (RA. 126, 144-182, 187-188), but he was handicapped by lack of formal education, lack of technical assistance and dependence upon the returns from his improvements for sustaining financial resources (RA. 270). So he relied, and had to rely, upon the protection of the patent law, and not merely as to the form of machine in which his improvements were first disclosed.

His Control invention started in 1923 in one form (RA. 191-194), progressed in 1924 through another which was built but was discarded in early 1925 as too complicated and expensive (RA. 202-206); then was worked upon in a form to use electrically motivated elements (RA. 207); and in October of 1925 it attained the form first used successfully for sugar manufacture, which is the one illustrated in the Control patent (RA. 221). But the development did not stop there. Other forms followed as shown in his related patents*, Nos. 1,719,132, 1,861-

* These copending patents show common subject matter claimed basically in the Control patent. The Circuit Court of Appeals disregarded them in considering the Control patent, but they are pertinent to its construction. *Weber Electric v. E. H. Freeman*, 256 U. S. 668, 676; *Monitor v. Williamson*, 209 Fed. 1, 3 (C. C. A. 6th, 1924).

978 and 2,145,633 (Ex's. 2, 3 and 4, RB. 688-692, RA. 83); and then still others among which were some using electrically motivated timers and connections (RA. 169-171), as do respondent's machines.

Roberts' need and expectation of patent protection for the full substance of his advance appear clearly from letters he wrote as the developments progressed—those of 1924 and 1925 to patent counsel (Ex's. 26, 29 and 30, RB. 706-709, RA. 195, 206, 207), and those of October, 1925, to an associate (Ex's. 32 and 33, RB. 710-714, RA. 222). In the last he stated:

"I am going to Boston tonight so as to get all the protection it is possible to get on this controlling arrangement. I am also taking along our old records showing when we first started development work * * *. I want to cover this both electrically and mechanically if possible. As soon as our competitors see how simple this is they will no doubt try to infringe."

This prediction was soon realized by the activities of *Steps* and his company, which became licensed to continue with its different forms of the Roberts combinations when the Control patent had issued (RA. 304-306). It was realized again in 1936 by respondent's activities giving rise to this suit (RA. 306-309).

To confine the claims of the Control and Brake Cooling patents to their illustrative mechanical forms, as the Circuit Court of Appeals has done in this case where their terms cannot fairly be so construed, seems clearly "an evasion of the law", "so obviously unjust that no court could be expected to adopt it", and contrary to the applicable decisions of this court.

The court was not justified by either the specifications or the prior art in refusing to enforce valid claims of the Control and the Brake Cooling patents, or in circumscribing them to illustrative details.

The rights secured by a patent are made enforceable by law, and it is the plain duty of a court to enforce valid claims as granted, according to a fair construction of their terms, unless the party charged with infringing them makes out a defense.

Here the respondent's defenses were invalidity and non-infringement of the claims. To their presumptive validity, however, the district court added affirmative findings of validity as to the claims of the Control patent and claim 9 of the Brake Cooling patent, and those findings were not reversed by the Circuit Court of Appeals. Indeed, it referred to the Control invention as "meritorious" and did not deny that each patent distinguished a useful and important advance.

The comments of the Circuit Court of Appeals as to the quantum of ingenuity it might seem theoretically to require to add "drying" control to Carlson's alleged operations, or to turn off the cool water supply to a brake drum as it came to rest, cannot be taken as holdings that those claims are invalid. It is evident from the opinion that the court did not adjudicate their validity and did not reverse, but rather accepted, the district court's findings that they were not anticipated and were for important advances having the character and effects of patentable inventions. It did not hold the claims invalid as importing nothing beyond the skill of mechanics at the time of Roberts' work; that would have violated the facts.

The defense remaining, then, was non-infringement. The construction of the patents called for in that regard may properly invoke their specifications and the prior art for a better understanding of the terms and scope of the claims.

But the quantum of ingenuity that might seem entailed in a theoretical endeavor to satisfy some of their distinguishing terms, such as in theoretically adding "drying" control to *Carlson* or merely turning off a cool water supply to a brake, plainly is not relevant to the construction of the claims.

That this be so inheres in the rule that the claim measures the scope of protection, for otherwise not the claim but theoretical considerations of degrees of ingenuity divorced from practical things would be the measure of what a valid patent does or does not cover. So it was held in *Mason v. Graham*, 23 Wall. (90 U. S.) 261, 274, that evidences of a state of the art which did not anticipate an invention would not justify construing it to cover only a combination having an element of particular form—

"they exhibit no such state of the art as requires that construction to be given to the patent, and we cannot perceive that such a construction is justified by the language of the specification and claims."

That the claims of the Control patent and claim 9 of the Brake Cooling patent are not restricted to the illustrative embodiments of the specifications is plain from reading them, and from the opinion and findings of the district court, and from the observation of the Circuit Court of Appeals that "all claims are in some respects more general than the specifications" (RE. 173).

That these claims are not required to be restricted to avoid covering prior art is equally plain.

As to the Control patent, the district court held that *Carlson's* proposal "is not the Roberts invention" (RA. 38). The Circuit Court of Appeals acknowledged that Roberts provided operations not found in *Carlson* (RE. 169, 172), although their import was misunderstood and confused with vague concepts of "automaticity." Claim 3, for example, specifies a combination of five elements as a com-

plete, operative entity which *Carlson* lacks altogether, and *Carlson's* combination of three elements has no element in common with that claimed, unless it be the timer element which he proposed and disclosed incompletely for a different use. Claims 1, 4, 5, 9 and 10 each distinguishes combinations unlike *Carlson's* in still further respects.

The most respondent's expert could say of *Carlson* was that its combination would correspond to a hypothetically isolated segment of respondent's machine (RA. 551), far less than the machine as a whole (RA. 549-551) and as far from the entity that is the Roberts invention.

As to the Brake Cooling patent, its system embodies two distinct elements of novelty which are distinguished from everything old by claims 8 and 9. Since the elements these claims specify were essentials of an important advance in the art, the Circuit Court of Appeals was not justified in confining claim 9 to details destructive of its intended substance and not within the fair import of its terms.

The Use Made of Carlson Unduly Extended the Rule of the Milburn Case

The courts below agreed that *Carlson's* application did not disclose the combinations claimed in the Control patent. His combination, elements, operation and results were all different.

This being so, *Carlson* does not demonstrate that Roberts was not the first inventor of the claimed combinations, but rather the contrary. The defense of prior invention under Revised Statutes § 4920, U. S. Code, Title 35, Sec. 69, was not made out; nor any other statutory defense.

In other words, the Roberts invention was not anticipated. Had it been, the claims would be invalid; but they were not found so. Since *Carlson* is not within any interpretation to which the claims are susceptible, such as to

limit their construction, and since respondent uses the Roberts combinations rather than *Carlson's*, there is no further capacity in which the reference properly could be considered pertinent.

The only other defense for which it might be invoked was that in view of the state of the art prior to the date of Roberts' work the improvements patented involved "merely the expected skill of those skilled in the art" (RC. 3, Answer). This defense, too, was not established. It is one to which *Carlson* is not pertinent, for his proposal was pending in secrecy until 1928 and was not a part of the teachings available to those skilled in the art at the date of the Roberts invention in 1923. To consider the matter otherwise is a pure fiction, which the law does not favor and which would establish a basis for the avoidance of patents having no relation either to the defenses provided by statute or to the question whether the matter claimed resulted from inventive ingenuity or had the character and effect of a patentable invention.

The Circuit Court of Appeals overlooked these considerations, and misinterpreted the basis and effect of the *Milburn Case*, 270 U. S. 390. It went so far as to give *Carlson* the fiction of having been published on its 1922 filing date, and to add the further fictions that Roberts presumably knew of *Carlson* at that time and that his claims somehow could not be good for what they cover because the advance acknowledged to have been made came "only a year after *Carlson* filed" (RE. 172). Yet the plain facts are that *Carlson* was not then published or known to Roberts or others, and in no respect did it reduce the ingenuity residing in, or the difficulty of bringing about, the Roberts invention. *Carlson*, indeed, is evidence of a far greater ingenuity and advance on the part of Roberts than was within the grasp of contemporary inventors in the art. If any part of the Roberts combinations corresponds to *Carlson's*, the whole of Roberts required not only such inven-

tiveness as *Carlson* displayed but also the further concepts that made the Roberts machine the exceptionally beneficial and successful advance that it actually was.

The Circuit Court of Appeals has given a greater effect to *Carlson's* conception than if it had been published and known long before Roberts' invention, for it does not anticipate, and the short time interval between the two conceptions was held as an element against Roberts. Yet the fact is, as it was in *O'Reilly v. Morse*, 15 How. (56 U. S. 62, 108), that "**** neither inventor can be justly accused of having derived any aid from the discoveries of the other".

While this court seems never to have decided the precise question here presented, the decision of the Circuit Court of Appeals is in logical conflict with *Mason v. Gramm*, 23 Wall. (90 U. S.) 261, 274; *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 440, 441; *The Corn-Planter Patent*, 23 Wall. (90 U. S.) 181, 211; and other cases. In the case last cited, it was held that a mere application for a patent "can only have a bearing on the question of prior invention or discovery". That is the only capacity in which the *Milburn Case* held the application of an earlier-filed, copending patent to be pertinent.

The decision of the Circuit Court of Appeals conflicts with its own prior decisions and those of other federal courts in the cases cited at the footnotes on pages 13 and 14 of the petition.

If the decision in this case is the law, a drastic change seems requisite in the practice of the Patent Office. It is not now the practice, but would have to become so, to defer examination of and reject any pending application upon the existence of earlier-filed copending applications claiming different combinations, if they but show an analogous element; also, to assume that everything contained in pending applications was published and known to whomever may

have filed later; and also to base the determination of whether patentable invention was involved in any claim upon that assumption and the theoretical ease of combining with the assumed knowledge the further elements required by the later applicant's claim, rather than upon the character and effect of his claimed invention as a practical entity.

The Claims in Issue Were Clearly Infringed

The opinion of the district court demonstrates this completely. The Circuit Court of Appeals conceded as much and found it necessary to change the claims in order to hold them not infringed.

Since respondent's machines embody the parts, improvements and combinations disclosed and claimed as the Roberts inventions, and operate in the same way to achieve the same result, they are infringements, however dissimilar their details and form may make detailed drawings of them appear in comparison with the patent drawings. *Cochrane v. Deener*, 94 U. S. 780, 789; *Deering v. Winona Harvester*, 155 U. S. 286, 302; *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 41, 42.

Respondent's expedient of substituting different motivations of parts and attendant changes of form to avoid the illustrations of the patents was an available one (RA, 408-409), and one that has been repeatedly rejected by the courts. *Blake v. Robertson*, 94 U. S. 728, 732, 733 (substitution of hydraulic for mechanical motivation); *National Ticket v. Automatic Ticket*, 40 F. (2d) 458, 459 (substitution of mechanical for electrical automatic control); *Mills Novelty v. Monarch*, 76 F. (2d) 653 (substitution of switch-to-rely motivation for mechanical lever).

The Claims of the Separator Patent Were Improperly Held Anticipated By Holland

Courts have held patents increasingly accountable to the constitutional purpose of advancing the useful arts, but it has not heretofore been held permissible to invalidate a patent that unquestionably represents an important advance upon inferences and presumptions added to one that unquestionably did not.

In *Whitely v. Swayne*, 7 Wall. (74 U. S.) 685, 686, this court dismissed a suit on such a patent as *Holland's*, saying of the claimed improvements that:

"They never went into any useful or practical operation, and nothing more was heard of them from Steadman or any other person, for a period of six years";

and adding further:

"If any other person had chosen to take up the subject of the improvements, where it was left off by Steadman, he had a right thus to enter upon it, and if successful, would be entitled to the merit of them as an original inventor, for he is the first inventor, and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use".

There was a strong burden of proof upon respondent, an infringer, in asserting a prior invention to invalidate the Separator claims. *Coffin v. Ogden*, 18 Wall. (85 U. S.) 120. If any presumption of operability or sufficiency were otherwise attributable to *Holland's* disclosure it was over-balanced by the fact of *Holland's* uselessness during over 30 years of need and by the presumption of validity of the claims in suit.

*** * * one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has

more than a dubious preponderance". R. C. A. v. Radio Engineering, 293 U. S. 1, 7, 8 (Italics added).

But since the description of *Holland's* Fig. 4, as invoked by respondent and interpreted by the Circuit Court of Appeals, was not the invention claimed in the patent, it acquired no presumptive utility from the grant. And since no evidence was given of its operability, sufficiency or utility, there was *nothing* to sustain respondent's burden of proof or to warrant holding *Holland* an anticipation. To recommend something in the specifications, where the claim does not embrace it, does not constitute it a portion of what was patented. *Sewall v. Jones*, 91 U. S. 171, 185, 186.

The description invoked therefore had no greater legal standing than a prior publication, and it was respondent's burden to show that it exhibited the Roberts invention in such full, clear and exact terms as to enable any person in the art to construct it and carry it into practical use. *Eames v. Andrews*, 122 U. S. 40, 66.

There was no evidence whatsoever to sustain this burden. The situation, indeed, is like that in *DuBois v. Kirk*, 158 U. S. 58, 65:

"The device, the operation of which is not very clearly shown in the patent, seems to have a different object from that of the Kirk patent, and employs quite a different means. * * * Nor does defendant's expert make any reference to it. There is nothing in his testimony to indicate that the device which this patent describes accomplishes the same result or works in the same way as Kirk's invention; * * *. We do not find it to have been an anticipation of the Kirk patent".

The very facts that *Holland* issued in 1902, that the art needed but lacked a successful syrup separator until the Roberts invention in 1933, and that respondent offered no evidence of having built or tested a device

according to *Holland*, show more conclusively than testimony the ineffectiveness of the disclosure. *Whitely v. Swaine, supra; Scovill v. Satler, infra.* As said of an alleged anticipation in *O'Reilly v. Morse*, 15 How (56 U. S.) 62, 110, "We have nothing to show that his invention ever was or could be carried into successful operation". Yet here there was also undisputed testimony that the *Holland* proposal would be impractical to make, and that it is not operative to achieve syrup separations. To be as described the annular plate device would have to seal simultaneously upon *two* spaced circular seats of large diameter, on one of which syrup and sugar crystals would lodge with the result of holding the device up and preventing the requisite sealing upon the other. (RA. 673-675; Ex. 85, RB. 775, RA. 673)

Moreover, *Holland's* description of Fig. 4 is incomplete on its face, because it mentions nothing—seat, ledge or otherwise—to seal the outer edge of the plate (unless the plate be always in contact with the casing as he claimed), and it provides nothing for lifting and lowering the plate. There was no evidence that either of these elements might have been supplied by those skilled in the art, nor as to how. They never were. The Circuit Court of Appeals was not warranted in assuming their existence in operable form.

Coffin v. Ogden, 18 Wall. (85 U. S.) 120, 124:

"The law requires not conjecture, but certainty. If the question relate to a machine, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility".

Seymour v. Osborne, 11 Wall. (78 U. S.) 516, 552:

"* * * In order to constitute an invention, the party must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form".

See also *Ideal Stopper v. Crown Cork & Seal*, 131 Fed. 244 (C. C. A. 4th), cert. denied, 195 U. S. 633; *Scovill v. Satler*, 21 F. (2d) 630, 634. The *Scovill* case was cited by the Circuit Court of Appeals to support the decision here, but it holds quite to the contrary as to the Reuthe patent there urged as an anticipation:

*** * * it is inconceivable that the device suggested would not have been seized upon in the several years before Lowenstein's patent and embodied in a practical condenser. The fact that it did not so instruct condenser builders justifies the conclusion that the disclosures were not sufficient to instruct them."

Furthermore, the ambiguities plain on the face of the *Holland* patent are themselves enough to prevent it anticipating the successful invention made by Roberts decades later, for *Holland* is susceptible to two conflicting interpretations, and the one required by his general description and claims could not anticipate. *Ideal Roller v. Sutherland Paper*, 96 F. (2d) 675, 677 (C. C. A. 6th); *In re Cramblet*, 62 F. (2d) 358, 359 (C. C. P. A.), and cases there cited.

Claim 8 of the Brake Cooling Patent Was Improperly Held Invalid

The Circuit Court of Appeals has nullified the effect of this patent by deductive reasoning applied to claims 8 and 9. Yet there can be no doubt that the patent disclosed an advance, not previously anticipated or suggested, of extraordinary utility and success. It has been the instrument for providing high speed centrifugal machines, with all the great economies they import. The key to this important result is the constant maintenance of a body of water in the brake drum while it is either rotating or at rest. The brake drum arrangement of claim 8 is essential to that. Roberts conceived its usefulness, and it was never known before.

The claim may not explain the principles involved as perfectly as it might if written today. But to condemn it as being merely for "plugging up a hole" is to close one's eyes to the new function and result of the new structure it disclosed, and is to strike down the claim for the mere simplicity of its verbal distinction from the closest brake drum of the prior art. To condemn the claim as being "useless" simply disregards the fact that the structure it describes has been used successfully by petitioner, and by respondent in imitation, to accomplish new results. The reason given by the Circuit Court of Appeals for calling the claim useless was that it must otherwise presuppose a stoppage of the cool water supply, and that the latter could not be inferred because it occurs in claims 9 and 10. But the court then proceeded to confine claim 9 to details of form, and since claim 10 previously had been held narrow, the result of the court's reasoning was to leave no claim standing for either the maintenance of a body of water in the brake drum or the stoppage of the cool water supply in coordination with each stoppage of the machine. These, however, were held to be patentable features in the district court; they account for Roberts' success; and they were plainly the intended subjects of his claims.

It is no objection to the validity of claim 8, nor to the scope of claim 9, that but a simple change of prior structure was required to bring forth the improvement, for it had the practical character and effect of a meritorious advance. *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 440, 441; *The Barbed Wire Patent*, 143 U. S. 275, 282;

*** * The difference between the Kelly fence and the Glidden fence is not a radical one, but slight as it may seem to be, it was apparently this which made the barbed-wire fence a practical and commercial success."

Seymour v. Osborne, 11 Wall. (78 U. S. 516, 548):

"* * * if the change of construction and operation actually adapts the machine to a new and valuable use not known before, and it actually produces a new and useful result, then a patent may be granted for the same and it will be upheld as a patentable improvement".

This court in *Deering v. Winona Harvester*, 155 U. S. 286, 302, held a claim valid over precisely the argument used against claim 8 by the Circuit Court of Appeals. The issue concerned claim 20 of the Steward patent. Defendant insisted that the claim was incomplete, inoperative and invalid, though it specified a new pivot board, in that the means necessary for holding and controlling the board were not recited; and it argued that the additional elements could not be read into the claim because they occurred in claim 21, which of course it had avoided. But the court stated:

"Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described in the patent as rendering it operative must be read into the claim. If Steward were in fact the first to invent the pivotal extension to a butt-adjuster, he is entitled to a patent therefor, though the infringer may make use of other means than those employed by him to operate it".

Respectfully submitted,

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NELSON LITTELL,
Counsel for Petitioner.

APPENDIX

STATUTES CITED IN BRIEF

Revised Statutes:

Sec. 4886 (U. S. Code, Title 35, Sec. 31): Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, * * *.)

Sec. 4888 (U. S. Code, Title 35, Sec. 33): Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and

he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

Sec. 4920 (U. S. Code, Title 35, Sec. 69): In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

(Note: The Act of Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212, substituted "one year" for "two years" in the third and fifth subdivisions, effective from Aug. 5, 1940).





IN THE

Supreme Court of the United States

OCTOBER TERM, 1944

No. 1251

THE WESTERN STATES MACHINE COMPANY,
Petitioner,

vs.

S. S. HEPWORTH COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI

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IN THE
Supreme Court of the United States

OCTOBER TERM, 1944

No. 1251

—0—

THE WESTERN STATES MACHINE COMPANY,
Petitioner,
v.

S. S. HEPWORTH COMPANY,
Respondent.

—0—

**RESPONDENT'S BRIEF OPPOSING PETITION FOR
WRIT OF CERTIORARI.**

The petition does not present any question of conflict of opinion between Circuit Courts of Appeal nor any question of general or public importance. The suit is an ordinary one for alleged patent infringement decided adversely to the patents on orthodox principles well settled among the circuits and by this court.

OPINIONS BELOW.

The opinion of the Circuit Court of Appeals for the Second Circuit is reported in *147 Fed. (2) 345 (Adv. sheet #3)* and the opinion of the District is reported in *51 Fed. Sup. 859*. A supplemental opinion of the District Court is not reported but is printed in Volume A of the record, at page 64.

STATEMENT OF THE CASE.

The petition mentions three patents 1,758,901, (the Control Patent), 2,096,341 (the Brake Patent) and 2,145,633 (the Separator patent). Two other control patents were also involved in the suit; both were held not infringed and have been dropped.

Both infringement and validity of all patents were challenged.

The Control Patent.

Validity of this patent was attacked on the grounds of anticipation, of prior public use and of lack of invention. The Court of Appeals did not pass upon any of those grounds, except insofar as it found the prior control of the Carlson patent to require a limitation of the claims in suit if they were to have any validity. On that score the court said:

“This does not mean that we must hold the claims invalid for *all*¹ purposes. When a patentee has disclosed a meritorious invention, but has claimed it too broadly he is not always forced to a reissue; courts will at times read into the broad language limitations drawn from the specifications, which save the claims as they stand.”

The implication plainly is that the court was faced with these alternatives: It could find the claims invalid because too broadly drawn, or it could read them as they might have been drawn and find them not infringed. The Court took the second alternative.

Then, as to the other defenses, the court took pains to say:

¹ Italics throughout the brief are supplied by respondent.

"We need not consider the Andrews & Newman patent, or any of the other references;² although we do not wish to be understood as holding that they too may not be a sufficient answer."

Hence the important question of validity would require this court's detailed consideration if there were sufficient reason to grant the writ to review the appellate court's findings of non-infringement.

The Control patent³ is based on an intricate assembly of devices including links, levers, gears and a timing mechanism of an odd and particular sort, for measuring the duration of the three periods of centrifugal operation (called purging, washing and drying periods) and to set the brake automatically. The controls of the patent in suit are entirely mechanical.

In contrast the accused controls⁴ are electrical, simply employing three common commercial electric time clocks to measure the duration of the purging, washing and drying periods.

The Carlson patent⁵ (whose system defendant employs)⁶ disclosed the use of electric time clocks to measure the duration of the purging and washing periods; and the prior patent to Andrews & Neuman⁷ disclosed a time clock to terminate the drying period and to set the brake for automatically stopping the machine. But the appellate court correctly held⁸ that (even without the dis-

² The several defenses relied on in the Court of Appeals are found in the "Statement of Points of Defendant-Appellant" (Vol. C, p. 563).

³ Rec. Vol. B, pp. 686, 754

⁴ Vol. B, pp. 786, 788, 790

⁵ Vol. B, p. 782

⁶ Vol. A, p. 37

⁷ Vol. D, p. 614; Vol. B, p. 776

⁸ Vol. E, p. 172

closure of Andrews and Neuman) the addition of a third time clock to Carlson's system, to carry automaticity beyond the purging and spraying periods, would be no warrant for allowing it to be the basis of a patent. Therefore the appellate court logically concluded as to the claims in suit:

"The only invention, which can support them at all, lies in the specific timing mechanism, together with its accompanying train of mechanical elements. To that defendant owes nothing; its whole system has a totally different structure and a totally different provenience." (Rec. Vol. E, p. 173.)

The case therefore does not involve, as Petitioner argues, an evasion of the patent by mere difference in form. The accused controls are, as the appellate court found, "a totally different structure" than the patented control.

But even if plaintiff's argument was accurate, the basis for review would be merely factual, which is insufficient by itself for grant of the writ.

The Brake Patent.

This patent⁹ is based on a brake cooling system, wherein water is let into a hollow rotating brake drum by an inlet pipe and any excess is scooped out by an offtake or scoop pipe as the drum rotates. Review is asked only as to claims 8 and 9.

Concurrent decisions below held claim 8 invalid over a public use at the Baltimore refinery of the American Sugar Refining Company. No sound reason appears why the petitioner should be accorded a third hearing on valid-

⁹ Vol. B, p. 694

ity of a claim twice held invalid in view of the same prior use structure.

Claim 9 differs from claim 8 by including as an additional element a valve in the inlet line of the cooling system, which is operated by the brake lever to shut off the flow when not desired, i.e. when the brake is operated to bring the machine to rest.

The accused structure¹⁶ has no valve. Its means for interrupting the operation of the liquid supply is totally different from the patent. The appellate court thereupon based its finding of non-infringement. The decision is manifestly sound and in arriving at it the court followed established principles. Although the court hinted that the claim may be invalid for lack of invention, the court specifically refused to pass on validity and did not affirm the district court on that ground, choosing instead the alternative of holding the claim limited to "a measurably similar mechanical train" to that shown in the specifications. As so construed, the court could only hold the claim not infringed.

Manifestly the decision was correct and supplies no ground whatsoever for the petitioner to seek review. Claim 9 was not "changed" by the appellate court. No element was read into or out of the claim, nor does the petitioner give any clue as to how the claim was "changed" other than to say it was limited too greatly. That is a matter of opinion.

The court read claim 9 in the only way it is proper to read a patent claim—in the light of the specification, against the background of the prior art.

¹⁶ Vol. B, p. 795

The Separator Patent.

This patent¹ relates to a means for separating the two different syrups that are thrown off by centrifugal force during the purging and washing operations in a centrifugal machine, during the refining of sugar.

The patent relied on for anticipation was Holland 703,728² which was not cited in the Patent Office during the prosecution of the Separator patent. The appellate court unanimously held Holland "as complete an anticipation of claims 10 and 12 as can be imagined." (Vol. E, p. 175.)

There is no question for this court to review in connection with the Separator patent except the fact of sufficiency of Holland's specification to inform a person skilled in the art how to make and use his invention. Even if this court was disposed to review this decision on a fact question, there is not the slightest reason to suppose this court would find error. Each point recited by petitioner in the appellate court was considered individually in the opinion and, without hesitation, was rejected. In plain words the Separator patent was held invalid over a "pat" reference, in a clearly reasoned decision founded on sound and well established legal principles. It calls for no review on any of the grounds commonly required by this court in support of a writ of certiorari.

REASONS OFFERED BY PETITIONER FOR GRANTING THE WRIT.

I.

Petitioner's first reason is primarily, that the Appellate Court and District Court decisions are in conflict and secondarily, that for practical considerations suit can not be brought in another circuit for a second adjudication.

¹ Vol. B, p. 693

² Vol. D, p. 650; Vol. B, p. 803

1. The mere reversal of a district court decision and the holding of the patents in suit invalid or not infringed do not afford adequate grounds for grant of the writ.
2. The decision does not involve any question of general or public interest; and the inability¹ to sue in another circuit is not due to concentration of the industry in the second circuit nor to the concentration of sugar refineries and factories there. Hence *Exhibit Supply Co. v. Ace Patents*, 315 U. S. 126 and like decisions, wherein patents were held valid and infringed by the Appellate Court or the industry was concentrated in one circuit and the public was to be saddled with a monopoly, do not apply to this case.

II.

Petitioner's second reason raises an old question as to the effect to be given to a reference patent (Carlson). Carlson's patent issued on an application filed prior to the application for the control patent in suit and prior to the earliest date asserted for the invention of the control patent, but Carlson's application was copending with that of the Control patent.

This question has been settled uniformly among the circuits and by this court in *Detrola v. Hazeltine*, 313 U. S. 259. It is now universally held that a patent in suit must disclose invention over a prior patent whose application was prior to but copending with the patent in suit. The patent issued on the prior copending application is "prior art"; and patents issued on applications copending with that of the patent in suit may be combined with other patents if only mechanical skill is involved, to show lack of invention of the patent in suit. The point was decided or such combinations were made or both, in the following cases.

¹ Petitioner's citations to the record do not establish that as a fact.

Detrola Radio Corp. v. Hazeltine Corp., 313 U. S. 259, 85 L. Ed. 1319;
Hazeltine Corp. v. Abrams, 79 F. (2d) 329 (CCA 2);
Penmac v. Esterbrook, 108 F. (2d) 695, 696 (CCA 2);
Denaro v. Md. Baking Co., 50 F. (2d) 1074 (CCA 4), affg. 40 F. (2d) 513, 515-6; *Lemley v. Dobson-Evans*, 243 Fed. 391 (CCA 6); *Ottinger v. Ferro Mfg. Co.*, 59 F. (2d) 640, 643 (CCA 6); *Curtis Co. v. Master Metal Co.*, 125 F. (2d) 690 (CCA 7); *Gasifier Co. v. G. M. Corp.*, 138 F. (2d) 197, 200 (CCA 8); *Electrol Inc. v. Merrell & Co.*, 39 F. (2d) 873, 877 (CCA 8); *In re Minn. Mining Co. v. Coe*, 100 F. (2d) 429 (CCA DC); *Dyer v. Coe*, 125 F. (2d) 192, 196 (CCA DC); *In re Youker*, 77 F. (2d) 624 (CCPA); *Ex parte Bullowa & Ratish*, 56 U. S. P. Q. 421 (Pat. Off. B. of A.).

III.

The third and sixth reasons of petitioner allege that the Court of Appeals "changed" the claims by limiting them to what might be considered the invention, if there was any.

Such limitation is asserted to have been a departure from accepted legal principles and to have involved decisions on federal questions in conflict with applicable decisions of this court.

The principles applied by the Court of Appeals were the same principles as this court established more than half a century ago, in dealing with patent infringement

questions. This court has repeatedly limited claims to the means disclosed in the patent, in order to avoid the prior art, as was done by the appellate court in this case.

Pope v. Gormully, 144 U. S. 248, 253; 36 L. Ed. 423, 425;

Boyd v. Janesville, 158 U. S. 260; 39 L. Ed. 973; *Office Spec. Co. v. Fenton*, 174 U. S. 492, 498; 43 L. Ed. 1058, 1060;

Kokomo Fence Co. v. Kitselman, 189 U. S. 8, 23, 47 L. Ed. 689, 696;

Singer Mfg. Co. v. Cramer, 192 U. S. 265; 48 L. Ed. 437, 447;

Computing Scale Co. v. Automatic Scale Co., 204 U. S. 609, 622; 51 L. Ed. 645, 652.

The same principles have been followed by the courts below in cases too numerous to cite. Typical examples are in the courts opinion (Rec. Vol. E. p. 173).

The assertion that the limitations went beyond any "fair" construction of the claims, involves the assumption that limiting claims of the Control and Brake patents to the *means* therein disclosed, *for the reasons given by the court*, was unfair. Such an assumption is highly argumentative; and a review of the decision on that basis would involve purely fact matters.

Clearly the Court of Appeals neither departed from the accepted course of judicial proceedings nor decided any new question of federal law nor any federal question in any way conflicting with this court's decisions.

Basically petitioner's complaint against the Appellate Court's decision is that it did not repeat the errors made by the District Court in deciding the case. That court ignored the prior art when considering infringement. The scope accorded the claims for the purpose of infringement was never measured against the prior art.

IV.

Petitioner's fourth reason deals with claim 8 of the Water Cooled Brake patent against which there are concurrent decisions below as to invalidity; and his fifth reason deals with the Separator patent, as to which review would involve only reconsideration of the fact of operability of the reference patent (Holland) over which the Separator was held invalid.

The reasons are plainly inadequate to warrant granting the writ.

In view of the foregoing, it is respectfully submitted that the petition should be denied.

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May 31, 1945.

